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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/580,584

06/21/2006

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EXAMINER

HICKS, ROBERT J

ART UNIT

PAPER NUMBER

3781

MAIL DATE

DELIVERY MODE

06/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,584	Applicant(s) SHIMADA, SHINJI	
	Examiner ROBERT J. HICKS	Art Unit 3781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/25/2006, 7/30/2008, 2/24/2009</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 5 and 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The phrase "an essentially same type of material" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "same type of material"), thereby rendering the scope of the claim(s) unascertainable.

See *MPEP* § 2173.05(d).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 6-8 of Ota et al. (U.S. Patent No. 6,575,320) [Ota '320].

Although the conflicting claims are not identical, they are not patentably distinct from each other because Ota '320 states that the label is used to reinforce the container and add strength [Ota '320, Col. 3 Lines 53-56]. It would have been obvious at the time of the invention to one of ordinary skill, using the teaching, suggestion, and motivation within the prior art, to modify the label to be able to add strength to the container sidewall, as suggested by Ota '320, as "The heat shrink label serves to reinforce the container particularly when it is of a thin-walled structure" [Ota '320, Col. 3 Lines 53-55].

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

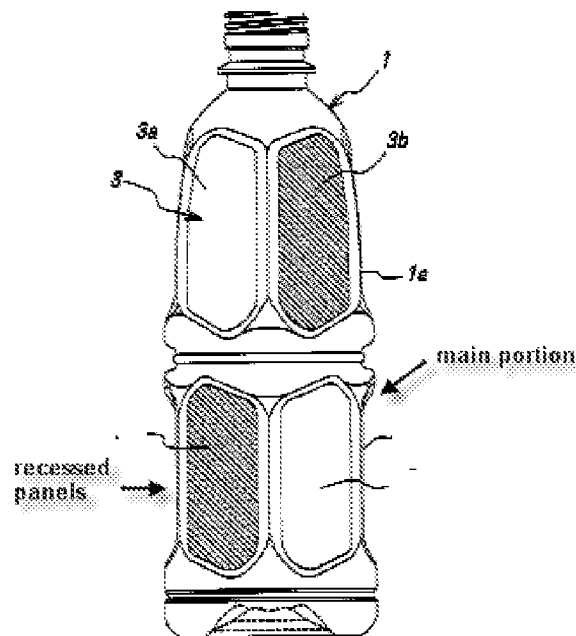
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Ota et al. (2002/0000421) [Ota '421].

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8. Regarding Claim 1, the publication to Ota '421 – a plastic bottle and label – discloses a synthetic resin container [1, Paragraph 21 Lines 1-7] comprising a container body, said container body having a main portion [1b] formed with a plurality of sectioned recesses [3b, Fig. 2], said container further comprising: a label arranged at said main body portion of the container body and surrounding the main body portion, for providing an improved rigidity of the container [Paragraph 26 Lines 1-6].



9. Regarding Claim 3, Ota '421 discloses said label is a heat-shrinkable label [Paragraph 26 Lines 1-6].

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 2 and 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota '421 as applied to claims 1 and 3 above, respectfully, in view of Itaba et al. (5,227,233) [Itaba].

13. Regarding Claim 2, Ota '421 discloses all the limitations substantially as claimed, as applied to claim 1 above. Ota '421 does not expressly disclose the features of claim 2; however, the patent to Itaba – a polyethylene label and container – discloses a container [Itaba, 1] in which said label [Itaba, 2] is immovably arranged through an adhesive layer [Itaba, 5, Col. 5 Lines 7-15, Col. 6 Lines 32-34]. It would have been obvious at the time of the invention to one of ordinary skill, using the teaching, suggestion, and motivation within the prior art, to modify the label on the Ota '421 container to have an adhesive to hold the label in place, as suggested by Itaba, in order to bond the label sufficiently to the container [Itaba, Col. 5 Lines 13-15].

14. Regarding Claim 4, Ota '421 in view of Itaba discloses all the limitations substantially as claimed, as applied to claim 2 above; further, Itaba discloses said label is a tack label [Itaba, Col. 6 Lines 32-34].

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15. Regarding Claim 6, Ota '421 in view of Itaba discloses all the limitations substantially as claimed, as applied to claim 2 above; further, Ota '421 discloses said label is a heat-shrinkable label [**Ota '421**, Paragraph 26 Lines 1-6].

16. Regarding Claims 5 and 8, Ota '421 discloses all the limitations substantially as claimed, as applied to claims 1 and 3 above, respectfully. Ota '421 does not expressly disclose the features of claims 5 and 8; however, the patent to Itaba discloses that said label [**Itaba**, 2] comprises the same material as said container [**Itaba**, 1, Col. 3 Lines 33-41]. It would have been obvious at the time of the invention to one of ordinary skill, with market forces driving one of ordinary skill to change the prior art, to modify the label in the Ota '421 container to be the same material as the container, as suggested by Itaba, to reduce manufacturing material costs, and so that the label can bond to the container through the manufacturing process [**Itaba**, Col. 3 Lines 37-41].

17. Regarding Claims 7 and 9-10, Ota '421 in view of Itaba discloses all the limitations substantially as claimed, as applied to claims 2, 4, and 6 above, respectfully; further, Itaba discloses said label [**Itaba**, 2] comprises the same material as said container [**Itaba**, 1, Col. 3 Lines 33-41].

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: see PTO-892 Notice of References Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT J. HICKS whose telephone number is (571)270-1893. The examiner can normally be reached on Monday-Friday, 8:30 AM -

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5:00 PM, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert J Hicks/
Examiner, Art Unit 3781

/Anthony D Stashick/
Supervisory Patent Examiner, Art
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